



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,086	06/16/2000	Elfi Biedermann	19711	3172
23389 7590 02/22/2007 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			EXAMINER COLEMAN, BRENDA LIBBY	
			ART UNIT	PAPER NUMBER
			1624	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/22/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/596,086

Applicant(s)

BIEDERMANN ET AL.

Examiner

Brenda L. Coleman

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 55-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 55-58 and 60-72 is/are rejected.
- 7) ☒ Claim(s) 59 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/15/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 55-72 are pending in the application.

This action is in response to applicants' amendment dated November 15, 2006.

Claims 55-60 and 70-72 have been amended and claims 73-77 have been canceled.

Response to Arguments

Applicant's arguments filed November 15, 2006 have been fully considered with the following effect:

1. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, first paragraph rejection labeled paragraph 5) of the last office action, which is hereby **withdrawn**.
2. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. § 102, anticipation rejection labeled paragraph 6) of the last office action, which is hereby **withdrawn**.
3. The applicants' filing of a terminal disclaimer is sufficient to overcome the obviousness-type double patenting rejection labeled paragraph 7) of the last office action, which is hereby **withdrawn**.
4. The applicants' arguments with regards to U.S. 6,313,153 are acknowledged and in view of the proviso excluding the 3-pyridyl in the definition of Ar¹.

In view of the amendment dated November 15, 2006, the following new grounds of rejection apply:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 55-58 and 60-72 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for other forms, does not reasonably provide enablement for solvates. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The claim is drawn to solvates. But the numerous examples presented all failed to produce a solvate. These cannot be simply willed into existence. As was stated in *Morton International Inc. v. Cardinal Chemical Co.*, 28 USPQ2d 1190 "The specification purports to teach, with over fifty examples, the preparation of the claimed compounds with the required connectivity. However ... there is no evidence that such compounds exist... the examples of the '881 patent do not produce the postulated compounds... there is ... no evidence that such compounds even exist." The same circumstance appears to be true here: there is no evidence that solvates of these compounds actually exist; if they did, they would have formed. Hence, applicants must show that solvates can be made, or limit the claims accordingly.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Art Unit: 1624

6. Claims 55-72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

a) Claim 55 is vague and indefinite in that it is not known what is meant by the second occurrence of "a substituted C₃-C₁₂-alkynylene which is substituted once or twice by C₁-C₆-alkyl, hydroxyl, C₁-C₆-alkoxy or phenyl" in the definition of D. See lines 5-6 on page 4 of the amendment and once again in lines 11-12 on page 4.

b) Claim 55 is vague and indefinite in that it is not known what is meant by the moiety C₁-C₆-acyl in the definition of R⁷.

c) Claims 55-58 and 60-72 are vague and indefinite in that it is not known what is meant by -NR¹¹-C(=O)-Y-(CR⁹R¹⁰)_m-R⁸, -NR¹¹-C(=Z)-NR⁸R⁹ and -C(=O)-Y-(CR⁹R¹⁰)_m-R⁸ as shown on page 6 (Claim 55), pages 11-12 (Claim 56), pages 15-16 (Claim 57), page 24 of (Claim 60), page 31 (Claim 70), pages 37-38 (Claim 72) and page 44 (Claim 72) of the amendment. It is believed that the applicants' have intended to delete this subject matter by cross through, however, in these three instances it appears as underlined, which is used for inserted subject matter.

d) Claim 56 recites the limitation "a substituted C₃-C₁₂-alkenylene which is substituted once or twice by C₁-C₆-alkyl, hydroxy or phenyl" in the definition of D. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 1624

- e) Claim 57 recites the limitation "a substituted C₃-C₁₀-alkenylene which is substituted by methyl, hydroxy or phenyl" in the definition of D. There is insufficient antecedent basis for this limitation in the claim. (With respect to claim 55)
- f) Claim 57 recites the limitation "a substituted C₃-C₁₂-alkylene wherein a methylene unit may be isosterically replaced by O or CO" in the definition of D. There is insufficient antecedent basis for this limitation in the claim.
- g) Claim 57 is vague and indefinite in that it is not known what is meant by the definition of the substituents on the aromatic ring systems on "R³ R⁸".
- h) Claim 58 recites the limitation "a substituted C₃-C₈-alkenylene which is substituted by phenyl" in the definition of D. There is insufficient antecedent basis for this limitation in the claim. (With respect to claim 55)
- i) Claim 60 recites the limitation "(G)-terminal methylene group in the C₃-C₁₂-alkylene, C₃-C₁₂-alkenylene or C₃-C₁₂-alkynylene, one to three methylene...." in the definition of D. There is insufficient antecedent basis for this limitation in the claim.

Election/Restrictions

7. The applicants are reminded that the compounds, compositions and method of use of the compounds of formula (I) of the instant invention have been searched to the extent that A is -CH=CH-; and G is G¹ or G². This includes the species of claim 59 where the 1st, 3rd, 4th, 6th, 7th, 8th and 9th species are the only species within this search.

Art Unit: 1624

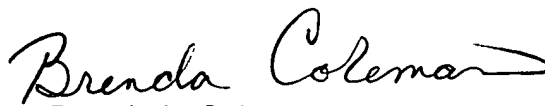
Claim Objections

8. Claim 59 is objected in that the claims possess non-elected subject matter, i.e. 2nd, 5th, 10th and 11th species in response to the Applicant's election with traverse of the compound 120 of Table I which is N-(6,6-di(phenyl)-hex-5-enyl)-3-pyridin-3-yl-acrylamide in the reply filed on February 23, 2006.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Brenda L. Coleman
Primary Examiner Art Unit 1624
February 16, 2007